

Remarks

I. Status of Claims

Claims 1 - 6 and 8 - 24 are pending in the application. Claim 7 has been canceled. Claims 1, 15, and 17-22 have been amended to recite that the microspheres are chosen from uncoated ceramic microspheres, uncoated polymeric microspheres, and uncoated metal microspheres. Support for these claim amendments can be found throughout the specification and claims as originally filed. See e.g., claim 7 as originally filed and page 4, first paragraph. Accordingly, these amendments do not add any new matter.

II. Claim Rejection under 35 U.S.C. § 102(b)

Claims 1 - 14, 20, 21, 23, and 24 are rejected under 35 U.S.C. § 102(b) as being unpatentable over U.S. Patent No. 5,093,108 to Pappas et al. ("*Pappas*") for the reasons set forth on pages 2 - 3 of the present Office Action. Applicants respectfully traverse this rejection.

For a reference to anticipate the pending claims, it must teach, either expressly or inherently, each and every claimed element. M.P.E.P. § 2131; *PIN/NIP, Inc., v. Platte Chem. Co.*, 304 F.3d 1235, 1243 (Fed. Cir. 2002). In the present case, *Pappas* fails to teach, expressly or inherently, each and every claim limitation of the claims as presently amended.

The Examiner asserts that *Pappas* teaches a nail enamel composition comprising, *inter alia*, pigments and "that the particles are milled to about 5 microns." See pages 2-3 of the present Office Action. As an initial matter, Applicants note that *Pappas*' discussion regarding particle size of about 5 microns refers to a particular thixotropic agent, stearalkonium hectorite, and not to pigments at all. See col. 13, lines 38-45. Stearalkonium hectorite is not a ceramic, a polymer, or a metal, and thus does not and cannot be considered to encompass the microspheres as presently claimed. Accordingly, *Pappas* fails to teach each and every limitation of the present claims.

For at least this reason, Applicants respectfully request withdrawal of this rejection.

III. Claim Rejections under 35 U.S.C. § 103(a)

Pappas

Claims 1-14, 20, 21, 23, and 24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Pappas* for the reasons set forth on pages 3 - 4 of the present Office Action. Applicants respectfully traverse this rejection.

In order to establish a prima facie case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. M.P.E.P. § 2143. In the present case, this requirement has not been satisfied.

As discussed above, *Pappas* discloses stearalkonium hectorite milled to about 5 microns. Also as discussed above, such disclosure fails to teach or suggest uncoated ceramic microspheres, uncoated polymeric microspheres, and uncoated metal microspheres. Nowhere else does *Pappas* discuss particles or microspheres. Accordingly, *Pappas* provides no motivation or suggestion to modify this reference to include microspheres chosen from uncoated ceramic microspheres, uncoated polymeric microspheres, and uncoated metal microspheres.

For at least this reason, Applicants respectfully request withdrawal of this rejection.

Pappas in view of Ellingson

Claims 15 and 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Pappas* in view of U.S. Patent No. 5,965,111 to Ellingson et al. ("*Ellingson*") for the reasons set forth on pages 4 - 5 of the present Office Action. Applicants respectfully traverse this rejection.

An Examiner must demonstrate, in order to establish a prima facie case of obviousness, that the reference (or references when combined) teach or suggest all the claim limitations. See M.P.E.P. § 2143. In the present case, the references do not teach or suggest all of the present claim limitations.

At least for the reasons discussed above, *Pappas* does not teach or suggest uncoated ceramic microspheres, uncoated polymeric microspheres, and uncoated metal microspheres. The Examiner asserts that "*Pappas* does not teach applying a nail enamel top coat" and therefore relies on *Ellingson* to cure this deficiency. However, *Ellingson*, like *Pappas*, fails to teach or suggest uncoated ceramic microspheres, uncoated polymeric microspheres, and uncoated metal microspheres. Accordingly, the teachings of the proposed combination of references fail to teach or suggest all of the present claim limitations.

For at least this reason, Applicants respectfully request withdrawal of this rejection.

Ellingson in view of Schlossman

Claims 15-19 and 22 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Ellingson* in view of U.S. Patent No. 5,356,617 to Schlossman ("*Schlossman*") for the reasons set forth on pages 5 - 6 of the present Office Action. Applicants respectfully traverse this rejection.

The Examiner admits that *Ellingson* fails to teach microspheres and therefore relies on *Schlossman* to cure this deficiency. *Schlossman* discloses a "pigment shell or **coating** on a low-density, organic, polymeric microsphere particle, or core." See col. 9, lines 20-22 (emphasis added). The microspheres can be organic polymeric materials or inorganic microsphere powders including silica, magnesium carbonate, and titanium dioxide. See col. 6, lines 53-64. The pigments are coupled by a liquid titanate coupling agent to the microspheres. See e.g., Abstract. Nowhere, however, does *Schlossman* teach or suggest uncoated microspheres according to the present invention. Accordingly, the proposed combination of references fail to teach or suggest all of the present claim limitations.

For at least this reason, Applicants respectfully request withdrawal of this rejection.

IV. Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully requests the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Attorney Docket No. 05725.0346-01
Application No.: 09/582,825
Customer No. 22,852

Please grant any extensions of time required to enter this response and charge
any additional required fees to our deposit account no. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P

By: *Thalia V. Warren*, Reg. No. 39,064
FDR
Anthony C. Tridico
Reg. No. 45,958

Dated: December 3, 2003
589715

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com